

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDGAR FREITAG
and GUNTER BERGMANN

Appeal No. 2001-2176
Application 09/031,186

ON BRIEF

Before MCCANDLISH, Senior Administrative Patent Judge, FRANKFORT,
and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Edgar Freitag et al. appeal from the final rejection (Paper No. 9) of claims 1, 2 and 5 through 11, all of the claims pending in the application.¹

¹ Claims 1 and 10 have been amended subsequent to final rejection.

THE INVENTION

The invention relates to a sealing ring which is defined in representative claim 1 as follows:

1. A sealing ring comprising:
a toroidal supporting body having a longitudinal axis, and a sloped, radially outer portion set at an angle with respect to the axis, the sloped portion of the supporting body being bound by two axially offset planes which define the axial extent of the slope,
a sealing body comprising a dynamically stressed sealing lip made of an elastomeric material which at least partially encloses the supporting body, the sealing body having a sloped surface facing the sealing lip, and the sealing body having a dynamically stressed sealing bulge on the side of the sealing lip facing away from a space to be sealed, said sealing bulge coming in tight contact with the surface to be sealed under an initial elastic stress, wherein the sealing bulge is arranged between the two radial planes in the axial direction which border the slope axially
wherein the sloped portion is in contact with the sealing body and the portion which contacts the sealing body faces toward the longitudinal axis of the toroidal supporting body.

THE REJECTIONS

Claims 1, 6 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,298,203 to Holzer et al. (Holzer).

Claims 2, 5, 7, 8, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Holzer.

Attention is directed to the appellants' brief (Paper No. 13) and to the examiner's answer (Paper No. 14) for the

respective positions of the appellants and the examiner with regard to the merits of these rejections.

DISCUSSION

We shall not sustain either of the examiner's rejections. For the reasons expressed below, the scope of claims 1, 2 and 5 through 11 is indefinite. Accordingly, the standing prior art rejections must fall because they are necessarily based on speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our decision in this regard rests solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejections.

The following rejection is entered pursuant to 37 CFR § 1.196(b).

Claim 1, and claims 2 and 5 through 11 which depend therefrom, are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable

degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. The purpose of this requirement is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

The following problems render the scope of the appealed claims indefinite.

Claim 1 recites a toroidal supporting body and "a sealing body comprising a dynamically stressed sealing lip made of an elastomeric material which at least partially encloses the supporting body." Normally, the words "made of an elastomeric material which at least partially encloses the supporting body" would be understood as referring to the immediately preceding

recitation of the sealing lip. As described and shown in the underlying specification and drawings, however, the sealing lip 2 does not at least partially enclose the supporting body 3. Hence, the language at issue appears, when read in light of the specification, to be inaccurate, and raises questions as to whether it should refer instead to the earlier recitation in claim 1 of the sealing body (as disclosed, the sealing body 1 is made of an elastomeric material and at least partially encloses the supporting body).

Claim 1 also recites that the sealing body has "a sloped surface facing the sealing lip." It is not clear what this sloped surface facing the sealing lip is, there being no apparent description of same in the specification. While the sealing body does have a sloped surface which contacts the sloped portion of the supporting body, this surface faces away from the sealing lip, not toward it.

Claim 1 further recites that "the sloped portion [of the supporting body] is in contact with the sealing body and the portion which contacts the sealing body faces toward the longitudinal axis of the toroidal supporting body." To begin with, it is unclear whether "the portion which contacts the sealing body" refers back to the sloped portion or to some other

portion of the supporting body. Moreover, the recitation in question, whatever portion of the supporting body it refers to, is inconsistent with the earlier recitation in the claim that the sloped portion is "a sloped, radially outer portion" of the supporting body. The latter recitation reads on the embodiment shown in Figure 1, but not the embodiment shown in Figure 2 (in Figure 2, the sloped portion cannot be accurately described as a radially outer portion because it is disposed on the radially inner periphery of the supporting body). In the Figure 1 embodiment, however, no portion of the supporting body which contacts the sealing body faces toward the longitudinal axis of the supporting body. Thus, read in light of the specification, the limitations in claim 1 requiring the supporting body to have both "a sloped radially outer portion" and a portion contacting the sealing body which "faces toward the longitudinal axis of the ... supporting body" do not make sense.

Claim 6, which recites that "the sloped portion of the supporting body is designed as an arch curved in the direction of the sealing lip" presents a similar inconsistency with respect to the recitation in parent claim 1 that the sloped portion of the supporting body is "set at an angle with respect to the axis" of the supporting body. The latter recitation reads on the

chamfered slope 12 shown in Figure 1, but not on the curved arch slope shown in Figure 2. Therefore, the content of claim 6 conflicts with that of parent claim 1.

Finally, the references in claims 1 and 2 to the "slope" and in claims 1 and 9 to the "radial planes" lack a proper antecedent basis.

SUMMARY

The decision of the examiner to reject claims 1, 2 and 5 through 11 is reversed, and a new 35 U.S.C. 112, second paragraph, rejection of these claims is entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejections shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of

Appeal No. 2001-2176
Application 09/031,186

rejections to avoid termination of proceedings (§ 1.197(c)) as to
the rejected claims:

(1) Submit an appropriate amendment of the claims
so rejected or a showing of facts relating to the
claims so rejected, or both, and have the matter
reconsidered by the examiner, in which event the
application will be remanded to the examiner. . . .

(2) Request that the application be reheard under
§ 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED; 37 CFR § 1.196(b).

HARRISON E. MCCANDLISH)	
Senior Administrative Patent Judge)	
)	
)	BOARD OF PATENT
)	
)	APPEALS AND
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
)	
JOHN P. MCQUADE)	
Administrative Patent Judge)	

Appeal No. 2001-2176
Application 09/031,186

JPM/kis

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004